

26. The portable radio telephone of claim 1 wherein the antenna is always biased towards a fully canted position whereby the antenna is stable in the fully canted position.

27. A portable radio telephone having an antenna which can be pivoted about an axis between a first position in which it projects from a surface of the telephone, and a second position in which it projects from a surface of the telephone, whereby the antenna may only pivot in a single plane, the antenna being biased and adapted to be locked as the antenna pivots.

REMARKS

In view of the foregoing amendments and following remarks, it is respectfully submitted that the claims of this application are now in a condition for allowance and favorable action thereon is requested.

Claims 1-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rydbeck (U.S. Patent 5,590,416) in view of Nagai (U.S. Patent 5,630,211). It is respectfully submitted that neither of these references whether considered by themselves or in any combination with each other disclose or even remotely suggest applicants' invention as defined by the claims.

Rydbeck discloses a cellular radiotelephone including an antenna that is movable between a first position and a second position. In the first position, the antenna is substantially parallel to the face of the radiotelephone thereby reducing the profile of the radiotelephone. Accordingly, the radiotelephone may be easier to store in a confined space such as a shirt pocket. In the second position, the antenna is canted away from the face of the radiotelephone thereby increasing the distance between the user's head and the antenna during use. Thus, the electromagnetic shielding caused by the user's head is reduced.

Nagai discloses a main body of a portable radio apparatus that is split into an upper box and a lower box, and the upper box is connected to the upper part of the lower box to be rotatable about a hinge section. An antenna is similarly connected to be rotatable on the hinge section. When the lower body is swung open, the antenna is also swung simultaneously. As the antenna can be further swung, the distance between the head of the user and the antenna can be maximized during communication.

The present invention relates to a portable radio telephone having a projecting antenna which may, for example, be a radio telephone such as a conventional handheld cellular telephone, or it may be a so-called smart radio telephone or personal organizer having radio frequency (RF) communication capabilities. According to the present invention there is provided a portable radio telephone having an antenna which can be pivoted between a first position in which it projects from a surface of the telephone, and a second position in which it projects from a surface of the telephone, whereby the antenna may only pivot in a single plane. The antenna is pivotable to one or more stable positions. The antenna is also biased towards and/or releasably locked in the stable positions. A user of the telephone may have the antenna of the telephone in the upright position most of the time. However, when a call is received by the telephone the antenna may be manually or automatically pivoted to an angled position for the duration of the call. Equally when the user initiates a call the antenna may be manually or automatically pivoted to the angled position for the duration of the call.

What is probably confusing the Examiner is the fact that the Rydbeck reference describes a radio-telephone with an antenna that addresses that same problem as the present invention but the means of achieving the end result is very different. It is respectfully submitted that the Examiner indicate where the references disclose or suggest structure for an antenna that is biased and

adapted to be locked as the antenna pivots. Rydbeck simply does not disclose such a mechanism. In fact, the antenna in Rydbeck is freely rotatable and may assume any position. The passages in Nagai cited by the Examiner do not remedy this deficiency, as they do not disclose such a mechanism either. They merely refer to a mechanism which causes the antenna to rotate in response to the opening of the clamshell telephone arrangement.

It is respectfully submitted to the Examiner that obviousness is a question of law. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 (Fed. Cir. 1987) cert. denied, 481 U.S. 1052 (1987). The courts have held that the proper approach to the obviousness issue starts with the claimed invention as a whole. *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1448 (Fed. Cir. 1984). The invention as a whole embraces the structure, its properties and the problem it solves. *In re Wright*, 848 F.2d 1216, 1219 (Fed. Cir. 1988). Section 103 is applicable when there is no single prior art item that completely discloses, i.e. anticipates, the claimed invention. *Kalman v. Kimberly-Clark*, 713 F.2d 760 (Fed. Cir. 1983).

The proper approach to making a determination of obviousness was described by the Supreme Court in *Graham v. John Deere Co.* 383 U.S. 1, 17 (1966);

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent are resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

To reject claims in an application under section 103, an Examiner must show an un rebutted prima facie case of obviousness. See *In re Deuel*, 51 F. 3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory

requirements is entitled to a patent. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See *In re Geiger*, 815 F.2d 686, 688 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Although the suggestion to combine references may flow from the nature of the problem, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.* 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), the suggestion more often comes from the teachings of the pertinent references, see *In re Sernaker*, 702 F.2d 989, 994 217 USPQ 1, 5 (Fed. Cir. 1983), or from the ordinary knowledge of those skilled in the art that certain references are of special importance in a particular field, see *Pro-Mold*, 75 F.3d at 1573 (citing *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n. 24 (Fed. Cir. 1985)). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" See *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

As the CAFC has stated in *In re Rouffet*, 47 USPQ2d 1453 (CAFC, 1998) at pages 1457 and 1458:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the

elements from the cited prior art references for combination in the manner claimed.

Enclosed is a check for \$390.00 for payment of a 2 month extension. The Commissioner is hereby authorized to charge account #16-1350 for any fee deficiencies with regard to the filing of this Amendment.

For all the foregoing reasons, it is respectfully submitted that all of the claims are now present in the application are clearly novel and patentable over the prior art of record. Accordingly, allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' Attorney at the telephone number indicated below.

Respectfully submitted

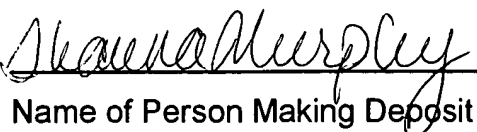

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CERTIFICATE OF MAILING

I hereby certify that the attached correspondence is being deposited with the United States Postal Service as first class mail on the date shown below in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, DC 20231.


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MARKED UP CLAIMS

1. (Twice Amended) A portable radio telephone having an antenna which can be pivoted about an axis between a first position in which it projects from a surface of the telephone, and a second position in which it projects from a surface of the telephone, whereby the antenna may only pivot in a single plane and through an acute angle, the antenna being biased and adapted to be locked as the antenna pivots.

18. (Amended) A portable radio telephone adapted for single handed operation having a non-retracting antenna arranged to be pivoted about an axis between a first position in which it projects from a surface of the telephone and a second position in which it projects from a surface of the telephone, the antenna being arranged to pivot in a single plane and through an acute angle, the antenna being biased and adapted to be locked as the antenna pivots.

21. (Amended) A portable radio telephone having an antenna which can be pivoted about an axis arranged internally of the telephone between a first position in which it projects from a surface of the telephone, and a second position in which it projects from a surface of the telephone, whereby the antenna may only pivot in a single plane and through an acute angle, the antenna being biased and adapted to be locked as the antenna pivots.